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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/500,866 | 07/21/2004 | Mikio Mori | 255735US90PCT | 3626 |
| 22850 | 7590 | 09/20/2005 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. | | | WONG, ERIC K | |
| 1940 DUKE STREET | | | ART UNIT | |
| ALEXANDRIA, VA 22314 | | | PAPER NUMBER | |

2883

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/500,866 | Applicant(s) MORI ET AL. | |
| | Examiner Eric Wong | Art Unit 2883 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/21/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>0704</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 15, 18, 21, 22, 25 and 28 are objected to under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation of “a plate having a heater or heat absorber provided on a non-heating side” is unclear to the Examiner. The Examiner is not clear as to how a **non**-heating side could have a heater thereon since a non-heating element inherently implies that no heat is generated on said side. Appropriate correction is requested.

Claim Rejections - 35 USC § 103

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 22-23, 25-26, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent Number 6,163,633 to Ueda.

Ueda discloses in figure 4, a temperature control element comprising:

- A plate having a heater or heat absorber thereon;
- A pedestal provided to support the plate (6);
- A sum of area of contact between the pedestal and the plate including the heater or heat absorber that is over 30% of the area of the plate.

As to claim 28, a waveguide module is disclosed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 15-16, 18-19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda as applied to claims above.

Ueda discloses a heater plate disposed on pedestals with a contact area greater than 30% and inherent roughness, but fails to explicitly disclose a sum of roughness with the value as claimed.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include components with the roughness values as claimed in order to provide better frictional support and since it has been held that discovering an optimal value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 27, 205 USPQ 215 (CCPA 1980).

6. Claims 17, 20, 24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda as applied to claims above.

Ueda and Ueda in view of optimal values above disclose the invention as claimed, but fails to explicitly disclose the use of ceramic materials.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a ceramic material in place of the materials disclosed, since it has been held to be within the general skill of a worker in the art to select a known material on the

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basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 07/21/2004 has been considered by the examiner and made of record (note the attached copy of form PTO-1449).

Priority

7. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. United States Patent Number 6,377,723 to Saito et al.
- b. United States Patent Number 5,822,848 to Chiang.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Wong whose telephone number is 571-272-2363. The examiner can normally be reached on Monday through Friday, 830AM - 430PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on 571-272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



EW



Frank G. Font
Supervisory Patent Examiner
Technology Center 2800